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TIMOTHY P. O'HAGAN 8710 KILKENNY CT FORT MYERS, FL 33912			ONYEZIA, CHUKS N	
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			3692	

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/053,193

Applicant(s)

MAGUIRE ET AL.

Examiner

Chuks Onyezia Esq.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/16/2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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**DETAILED ACTION**

***Claim Objections***

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 6-16 have been renumbered 7-17. Appropriate correction is required. When submitting corrected claim set, applicant is reminded to also correct claim dependency.

2. Claims 1 and 11 objected to because of the following informalities:

a. There are no conjunctions connecting claim elements A to claim elements B, a semicolon and 'AND' should follow claim elements A.

***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "723" of figure 7 has been used to designate both close/logoff and Uplevel. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the

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application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "723" and "729" of figure 7 have both been used to designate Up Level. Also, figure 7 makes reference to Up Level a third time without a reference character. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the

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applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference characters not mentioned in the description: 722 and 750 of figure 7 and 810 and 850 of figure 8. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference characters in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to under 37 CFR 1.83(a) because they fail to show 15, 16, 730, and 266 as described in the

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specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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***Specification***

7. The disclosure is objected to because of the following informalities:

a. Reference character 10 is described as an Electronic Bill Presentment and Payment System (EBPPS), however, Reference character 18 is labeled, in figure 1, as EBPP System.

b. Reference character 26b is first described as adjustment rules (see paragraph [0028] line 8) and later is referred to adjustment database (paragraph [0051] line 5).

Reference characters contain inconsistent descriptions.

Reference character 18 is first described as an Electronic Bill Presentment and Payment Module (EBPPM) (see paragraph [0027] line 5), and later is referred to as an EBPPS (paragraph [0027] line 11, paragraph [0028] line 1, and paragraph [0034] lines 10 and 15), an EBPP System (paragraph [0030] line 9, and paragraph [0035] line 4), and an IBSP (paragraph [0030] line 5). Reference character 26c is first described as Tax & Service Fee Data (see paragraph [0028] line 8) and later is referred to as Tax and Other Ancillary Item Data (paragraph [0039] line 15). Reference character 26d is first described as Biller Profiles (see paragraph [0028] line 6) and later is referred to as Payment Records (paragraph [0039] line 19). Reference character 720 is first described as an Invoice list (see paragraph [0050] line

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11) and later is referred to as Adjustment Call (paragraph [0051] line 1). Reference character 860 is first described as an update invoice records (see paragraph [0051] line 18) and later is referred to as obtain calculation data (paragraph [0051] line 20).

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1,3,7, and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is also, directed to a judicial exception to 35 U.S.C. 101 and is not directed to a practical application of that judicial exception. What is claimed is an abstract idea, in the form of a mathematical equation that is manipulated to calculate new values based on adjusting old values. Because the claim does not require any physical transformation and the invention as claimed does not produce a useful, concrete, and tangible result. A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360,



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31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also Schrader, 22 F.3d at 295, 30 USPQ2d at 1459.

10. Claims 1,3,7, and 9 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility. Claims 1, 3, 7, and 9 merely "provides" instructions wherein a customer could replace line values. Provision of elements, absent active involvement in an executable step does not create a useful result.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 1,3,7, and 9 are rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

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13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 1,3,7, and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The preamble of claims 1 and 7, in which 3 and 9 respectfully depend, is directed to a system for presenting a product sales invoice of a vendor to a customer. However, the body of the independent claim is not commensurate with the preamble, and does not actively achieve the goal of the preamble.

15. Claims 6, 11, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

16. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp.*

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*v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The terms "tax value" and "fee value" are used by the claims to mean "an amount payable by the customer as a tax on both the product and the second product" and "an amount payable by the customer as a fee on both the product and the second product" respectfully. However, independent claims 1 (which claim 6 depends), 7 (which claim 11 depends), and 12 (which claim 17 depends), define "tax value" and "fee value" as "an amount payable as a tax on the product" and "amount payable as a fee on the product" respectfully. The terms are indefinite because the definitions provided in the claims are inconsistent. 17. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to accompany a conditional phrase with a result to that condition being unmet. The claim is unclear because there is no indication of what happens when the 'if' statement is not satisfied.

***Claim Rejections - 35 USC § 102***

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

18. Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Remington et al., U.S. Patent No. 6,070,150.

19. As per claim 1, Remington teaches an electronic bill presentment and payment system for presenting a product sales invoice of a vendor to a customer, i.e. this invention concerns a bill presentment and payment remittance system for use over an electronic network . . . the bill presentment and payment remittance system allows the biller to create a bill and . . . The bill is presented to the consumer (see column 5 line 46); . . . billing database comprising means for storing an invoice file, said invoice file comprising a first product price line value, said product line value representing an amount payable by the customer for a taxable product provided by the vendor and said invoice file further comprising a tax line value representing an tax amount payable by the customer as a tax on said taxable

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product, i.e. the bill and payment remittance information are received at the network port and stored in data memory within a data structure, the data structure has several data fields which contain information specified by the biller and other data fields reserved to hold data entered by the consumer (see column 9 line 7), The bill presentment UI [user interface] has a main body portion which contains the billing particulars, such as the line items, the individual amounts for each item, and a total amount due and payable . . . each line item containing the purchase date, purchase order number, invoice number, item number, description of item, quantity, price, total, tax, and amount due (see column 10 line 34); an application server for receiving from said customer a request to adjust the line value, i.e. the bill presentment UI can be constructed with appropriate controls which enable a user to dispute an item . . . might contain additional columns which categorize pre-set reasons for challenging a billing items (see column 10 line 60); Providing, in response to said line value, instructions to replace the line value with an adjusted line value, i.e. the consumer can examine each purchase, line by line, if the consumer desires to challenge an item, the consumer simply clicks or otherwise selects the appropriate column cell (see column 11 line 23); calculating, for each adjusted line value, an adjusted tax value

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based on the adjusted line value and providing instructions to replace the tax value with the adjusted tax value, i.e. the bill presentment UI automatically adjusts the amount paid column to reflect the disputed amount (see column 11 line 32).

20. As per claim 2, Remington teaches the system of claim 1 as described above. Remington further teaches application server further provides means for notifying the vendor of the adjusted line value and the adjusted tax value, i.e. the bill might also be designed to enable a consumer to open a dialog box in conjunction with a disputed item, the consumer can write a detailed explanation for the challenge in the dialog box, when the consumer finishes and closes the dialog box, the text is saved and included in the remittance information to be returned to the biller (see column 11 line 40).

21. As per claim 3, Remington teaches the system of claim 1 as described above. Remington further teaches means for storing invoice records, means for storing adjustment rules, means for storing starting Tax & Service Fee Data, means for storing Biller Profiles, means for storing Payer Profiles, means for storing Business Service Provider Profiles, means for storing Accounting Systems Interface Application (ASIA) profiles, i.e. The bill and payment remittance information are received at the network port and stored in data memory within a data structure, the data

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structure has several data fields which contain information specified by the biller and other data fields reserved to hold data entered by the consumer (see column 9 line 7). Applicant states, "EBPP DATABASE 26 has storage which comprises all the data necessary to the function of the EBPP SYSTEM" (see paragraph [0028] line 5), also "EBPP DATABASE 26 may well be a 'relational database' the theory and operation of which are well-known to those of ordinary skill in the relevant art (see paragraph [0038] line 6). Examiner notes that it is well-known to those of ordinary skill that a relational database (see Dictionary of Multimedia and Internet Applications, 1999) is a form of data structure (see Academic Press Dictionary of Science and Technology, 1992) thus a suitable storage means.

22. As per claim 4, Remington teaches the system of claim 3 as described above. Remington further teaches the invoice file further comprises a fee value representing an amount payable by the customer as a fee on the product, i.e. the bill presentment UI also includes an "other invoices" button which, when activated, pops up a list of other invoices (see column 12 line 1; one skilled in the art at the time of invention would recognize an invoice as a list of fees or charges, and a fee value as being the amount or payment for an item or service, see Roget's II: The New Thesaurus, 1995), examiner interprets that

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applicant's defining of fee value, "an amount payable by the customer as a fee on the product" (see claim 1 on present application), and line value, "an amount payable by the customer for a product provided by the vendor" (see claim 3 on present application), are substantially similar; calculating, for each fee line value, an adjusted fee line value based on the adjusted line value, and providing instructions to replace the fee line value with the adjusted fee line value, i.e. the bill presentment UI automatically adjusts the amount paid column to reflect the disputed amount (see column 10 line 4).

23. As per claim 5, Remington teaches the system of claim 4 as described above. Remington further teaches the application server further provides for notifying the vendor of the adjusted line value, the adjusted tax value, and the adjusted fee value, i.e. the bill might also be designed to enable a consumer to open a dialog box in conjunction with a disputed item, the consumer can write a detailed explanation for the challenge in the dialog box, when the consumer finishes and closes the dialog box, the text is saved and included in the remittance information to be returned to the biller (see column 11 line 40).

24. As per claim 6, Remington teaches the system of claim 5 as described above. Remington further teaches the invoice file



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further comprises a second product price line value representing an amount payable by the customer for said second product provided by the vendor, the tax line value represents an amount payable by the customer as a tax on both said first product and on said second product, and the fee value represents an amount payable by the customer as a fee on both said first product and on said second product, i.e. The bill presentment UI also includes an "other invoices" button which, when activated, pops up a list of other invoices. Upon activation of the "other invoices" button, the bill presentment UI cycles among multiple bills from the same or different billers (see column 12 line 1).

25. As per claim 7, Remington teaches an electronic bill presentment and payment system for presenting an invoice of a vendor to a customer, i.e. this invention concerns a bill presentment and payment remittance system for use over an electronic network . . . the bill presentment and payment remittance system allows the biller to create a bill and . . . The bill is presented to the consumer (see column 5 line 46); the system comprising a billing database comprising means for storing an invoice file, said invoice file comprising a first product price line value, said product line value representing an amount payable by the customer for a taxable product provided by the vendor and said invoice file further comprising a tax

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line value representing an tax amount payable by the customer as a tax on said taxable product, i.e. the bill and payment remittance information are received at the network port and stored in data memory within a data structure, the data structure has several data fields which contain information specified by the biller and other data fields reserved to hold data entered by the consumer (see column 9 line 7), The bill presentment UI [user interface] has a main body portion which contains the billing particulars, such as the line items, the individual amounts for each item, and a total amount due and payable . . . each line item containing the purchase date, purchase order number, invoice number, item number, description of item, quantity, price, total, tax, and amount due (see column 10 line 34); an adjustment file comprising adjustment parameters established by the vendor, i.e. the data structure has several data fields which contain information specified by the biller and other data fields reserved to hold data entered by the consumer, some of the data fields are static or closed fields in that the consumer is prohibited from altering the data kept in those fields, other data fields are dynamic or open fields which allow the consumer to supply the data or alter the existing data (see column 9 line 12); an application server for receiving a request to adjust a product price line value from the customer,

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i.e. the bill presentment UI can be constructed with appropriate controls which enable a user to dispute an item . . . might contain additional columns which categorize pre-set reasons for challenging a billing items (see column 10 line 60); evaluating whether the request to adjust the line item is within the adjustment parameters, i.e. some of the data fields are static or closed fields in that the consumer is prohibited from altering the data kept in those fields. Other data fields are dynamic or open fields which allow the consumer to supply the data or alter the existing data (see column 9 line 12; examiner interprets the selection of dynamic fields as satisfying parameter see Academic Press Dictionary of Science and Technology, 1992); provides instructions to replace the product price line value with an adjusted product price line value, i.e. the consumer can examine each purchase, line by line, if the consumer desires to challenge an item, the consumer simply clicks or otherwise selects the appropriate column cell (see column 11 line 23); calculates an adjusted tax line value based on the adjusted tax line value, and provides instructions to replace said tax line value with said adjusted tax line value, i.e. the bill presentment UI automatically adjusts the amount paid column to reflect the disputed amount (see column 11 line 32).

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26. As per claim 8, Remington teaches the system of claim 7 as described above. Remington further teaches the application server further provides for notifying the vendor of the adjusted line value and adjusted tax value, i.e. the bill might also be designed to enable a consumer to open a dialog box in conjunction with a disputed item, the consumer can write a detailed explanation for the challenge in the dialog box, when the consumer finishes and closes the dialog box, the text is saved and included in the remittance information to be returned to the biller (see column 11 line 40).

27. As per claim 9, Remington teaches the system of claim 7 as described above. Remington further teaches the invoice file further comprises a fee line value representing an amount payable by the customer as a fee on the product, i.e. the bill presentment UI also includes an "other invoices" button which, when activated, pops up a list of other invoices (see column 12 line 1; one skilled in the art at the time of invention would recognize an invoice as a list of fees or charges, and a fee value as being the amount or payment for an item or service, see Roget's II: The New Thesaurus, 1995), examiner interprets that applicant's defining of fee value, "an amount payable by the customer as a fee on the product" (see claim 6 on present application), and line value, "an amount payable by the customer

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for a product provided by the vendor" (see claim 8 on present application), are substantially similar; the application server further provides for calculating, for each fee line value, an adjusted fee line value based on the adjusted line value, and providing instructions to replace the fee line value with the adjusted fee line value, i.e. the bill presentment UI automatically adjusts the amount paid column to reflect the disputed amount (see column 10 line 4).

28. As per claim 10, Remington teaches the system of claim 9 as described above. Remington further teaches the application server further provides for notifying the vendor of the adjusted line value and the adjusted tax value, i.e. the bill might also be designed to enable a consumer to open a dialog box in conjunction with a disputed item, the consumer can write a detailed explanation for the challenge in the dialog box, when the consumer finishes and closes the dialog box, the text is saved and included in the remittance information to be returned to the biller (see column 11 line 40).

29. As per claim 11, Remington teaches the system of claim 10 as described above. Remington further teaches invoice file further comprises a second product price line value representing an amount payable by the customer for said second product provided by the vendor, the tax line value represents an amount

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payable by the customer as a tax on both said first product and on said second product, and the fee value represents an amount payable by the customer as a fee on both said first product and on said second product, i.e. The bill presentment UI also includes an "other invoices" button which, when activated, pops up a list of other invoices. Upon activation of the "other invoices" button, the bill presentment UI cycles among multiple bills from the same or different billers (see column 12 line 1).

30. As per claim 12, Remington teaches an electronic bill presentment and payment system for presenting a product sales invoice of a vendor to a customer, i.e. this invention concerns a bill presentment and payment remittance system for use over an electronic network . . . the bill presentment and payment remittance system allows the biller to create a bill and . . . the bill is presented to the consumer (see column 5 line 46); system comprising a billing database comprising means for storing an invoice file, said invoice file comprising a first product price line value, said product line value representing an amount payable by the customer for a taxable product provided by the vendor and said invoice file further comprising a first tax line value representing an tax amount payable by the customer as a tax based on the price of said taxable product, i.e. the BPP [bill presentment and payment] application residing

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on the consumer's computing unit presents the bill to the consumer via the display, the BPP application gathers presentation data from the bill data structure and displays the presentation data within a unique graphical user interface designed by the biller (see column 9 line 59), The bill presentment UI has a main body portion which contains the billing particulars, such as the line items, the individual amounts for each item, and a total amount due and payable . . . each line item containing the purchase date, purchase order number, invoice number, item number, description of item, quantity, price, total, tax, and amount due (see column 10 line 34); said invoice file still further comprising a second tax line value representing a second tax amount payable by the customer as a tax based on the amount of said first tax line value, i.e. The bill and payment remittance information are received at the network port and stored in data memory within a data structure, the data structure has several data fields which contain information specified by the biller and other data fields reserved to hold data entered by the consumer (see column 9 line 7), Examiner notes that applicant effectively invokes 35 U.S.C. 112, second and sixth paragraphs, "If the corresponding structure, material or acts are described in the specification in specific terms and one skilled in the art could identify the

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structure, material or acts from that description, then the requirements of 35 U.S.C. 112, second and sixth paragraphs and are satisfied. See *Atmel*, 198 F.3d at 1382, 53 USPQ2d 1231. Examiner also notes that applicant is claiming a system with a means for storing an invoice file, not the invoice file itself, and the recited structure is an "EBPP.DATABASE 26 may well be a 'relational database' the theory and operation of which are well-known to those of ordinary skill in the relevant art (see paragraph [0038] line 6. Examiner notes that it is well-known to those of ordinary skill that a relational database (see Dictionary of Multimedia and Internet Applications, 1999) is a form of data structure (see Academic Press Dictionary of Science and Technology, 1992) thus a suitable storage means; an application server for receiving from said customer a request to adjust said product line value, i.e. the bill presentment UI can be constructed with appropriate controls which enable a user to dispute an item . . . might contain additional columns which categorize pre-set reasons for challenging a billing items (see column 10 line 60); providing, in response to said request to adjust said product line value, instructions to replace said product line value with an adjusted product line value calculating, for each adjusted product line value, an adjusted first tax line value based on the adjusted product line value



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providing instructions to replace the first tax line value with said adjusted first tax line value, calculating, for said adjusted first tax line value, a second adjusted tax line value based on said adjusted first tax line value and providing instructions to replace said second tax line value with said second adjusted tax line value, i.e. the bill presentment UI can be constructed with appropriate controls which enable a user to dispute an item . . . UI might contain additional columns which categorize pre-set reasons for challenging a billing items, such as tax exempt status (see column 10 line 60), upon insertion of the mark, the bill presentment UI dynamically adjusts the bill to reflect the consumer's challenges, the bill contains both dynamic data, which can be modified by the consumer inputs, and static data which cannot be modified (see column 11 line 1), if the consumer desires to challenge an item, the consumer simply clicks or otherwise selects the appropriate column cell (see column 11 line 24), the bill presentment UI automatically adjusts the amount paid column to reflect the disputed amount (see column 11 line 32).

31. As per claim 13, Remington teaches the method of claim 12 as described above. Remington further teaches a MEANS for notifying the vendor of the adjusted line value and the adjusted tax value, i.e. the bill might also be designed to enable a

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consumer to open a dialog box in conjunction with a disputed item, the consumer can write a detailed explanation for the challenge in the dialog box, when the consumer finishes and closes the dialog box, the text is saved and included in the remittance information to be returned to the biller (see column 11 line 40).

32. As per claim 14, Remington teaches the method of claim 12 as described above. Remington further teaches the billing database further comprises means for storing invoice records, means for storing adjustment rules, means for storing Tax & Service Fee Data, means for storing Biller Profiles, means for storing Payer Profiles, means for storing Business Service Provider Profiles, means for storing Accounting Systems Interface Application (ASIA) profiles, i.e. the bill and payment remittance information are received at the network port and stored in data memory within a data structure, the data structure has several data fields which contain information specified by the biller and other data fields reserved to hold data entered by the consumer (see column 9 line 7). Applicant states, "EBPP DATABASE 26 has storage which comprises all the data necessary to the function of the EBPP SYSTEM" (see paragraph [0028] line 5), also "EBPP DATABASE 26 may well be a 'relational database' the theory and operation of which are

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well-known to those of ordinary skill in the relevant art (see paragraph [0038] line 6). Examiner notes that it is well-known to those of ordinary skill that a relational database (see Dictionary of Multimedia and Internet Applications, 1999) is a form of data structure (see Academic Press Dictionary of Science and Technology, 1992) thus a suitable storage means.

33. As per claim 15, Remington teaches the method of claim 14 as described above. Remington further teaches the invoice file further comprises a fee line value representing an amount payable by the customer as a fee on the product, i.e. the bill presentment UI also includes an "other invoices" button which, when activated, pops up a list of other invoices (see column 12 line 1; one skilled in the art at the time of invention would recognize an invoice as a list of fees or charges, and a fee value as being the amount or payment for an item or service, see Roget's II: The New Thesaurus, 1995), examiner interprets that applicant's defining of fee value, "an amount payable by the customer as a fee on the product" (see claim 11 on present application), and line value, "an amount payable by the customer for a product provided by the vendor" (see claim 13 on present application), are substantially similar; application server further provides for calculating, for each fee line value, an adjusted fee line value based on the adjusted line value, and

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providing instructions to replace the fee line value with the adjusted fee line value, i.e. the bill presentment UI automatically adjusts the amount paid column to reflect the disputed amount (see column 10 line 4).

34. As per claim 16, Remington teaches the method of claim 15 as described above. Remington further teaches the application server notifying the vendor of the adjusted line value, the adjusted tax line value, and the adjusted fee line value, i.e. the bill might also be designed to enable a consumer to open a dialog box in conjunction with a disputed item, the consumer can write a detailed explanation for the challenge in the dialog box, when the consumer finishes and closes the dialog box, the text is saved and included in the remittance information to be returned to the biller (see column 11 line 40).

35. As per claim 17, Remington teaches the method of claim 16 as described above. Remington further teaches the invoice file further comprises a second line value representing an amount payable by the customer for a second product price line value representing an amount payable by the customer for said second product provided by the vendor, the tax line value represents an amount payable by the customer as a tax on both said first product and on said second product, and the fee value represents an amount payable by the customer as a fee on both said first

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product and on said second product, i.e. The bill presentment UI also includes an "other invoices" button which, when activated, pops up a list of other invoices. Upon activation of the "other invoices" button, the bill presentment UI cycles among multiple bills from the same or different billers (see column 12 line 1).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

36. Claims 1,2, and 6-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,2, and 7-11 of copending Application No. 10/014,378. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. Although the conflicting claims

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are not identical, they are not patentably distinct from each other because:

37. As per claim 1, 378' teaches, an electronic bill presentment and payment system for presenting a product sales invoice of a vendor to a customer, the system comprising a billing database comprising means for storing an invoice file, said invoice file comprising a first product price line value, said product line value representing an amount payable by the customer for a taxable product provided by the vendor and said invoice file further comprising a tax line value representing an tax amount payable by the customer as a tax on said taxable product, i.e. An electronic bill presentment and payment system for presenting an invoice of a vendor to a customer, the system comprising: a) a billing database for storing an invoice file comprising a line value representing an amount payable by the customer for a product provided by the vendor and a tax value representing an amount payable by the customer as a tax on the product (see claim 1a); an application server for receiving from said customer a request to adjust the line value, i.e. an application server for: i) receiving from said customer a request to adjust the line value (see claim 1b(i)); Providing, in response to said line value, instructions to replace the line value with an adjusted line value, i.e. Providing, in response

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to said line value, instructions to replace the line value with an adjusted line value(see claim 1b(ii)); calculating, for each adjusted line value, an adjusted tax value based on the adjusted line value, i.e. calculating, for each adjusted line value, an adjusted tax value based on the adjusted line value (see claim 1b(iii)); and providing instructions to replace the tax value with the adjusted tax value, i.e. providing instructions to replace the tax value with the adjusted tax value (see claim 1b(iv)).

38. As per claim 2, 378' teaches the system of claim 1 as described above. 378' further teaches the application server further provides MEANS for notifying the vendor of the adjusted line value and the adjusted tax value, i.e. application server further provides MEANS for notifying the vendor of the adjusted line value and the adjusted tax value (see claim 2).

39. As per claim 7, 378' teaches, an electronic bill presentment and payment system for presenting a product sales invoice of a vendor to a customer, the system comprising a billing database comprising means for storing an invoice file, said invoice file comprising a first product price line value, said product line value representing an amount payable by the customer for a taxable product provided by the vendor and said invoice file further comprising a tax line value representing an

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tax amount payable by the customer as a tax on said taxable product, i.e. An electronic bill presentment and payment system for presenting an invoice of a vendor to a customer, the system comprising: a) a billing database for storing an invoice file comprising a line value representing an amount payable by the customer for a product provided by the vendor and a tax value representing an amount payable by the customer as a tax on the product (see claim 6a); an adjustment file comprising adjustment parameters established by the vendor, i.e. an adjustment file comprising adjustment parameters established by the vendor (see claim 6b); an application server for receiving a request to adjust a product price line value from the customer, i.e. an application server for receiving a request to adjust the line value from the customer (see claim 6c); evaluating whether the request to adjust the line item is within the adjustment parameters, i.e. evaluating whether the request to adjust the line item is within the adjustment parameters (see claim 6c); whereby, if the request to adjust the product price line item is within said adjustment parameters, said application server provides instructions to replace the product price line value with an adjusted product price line value, i.e. if the request to adjust the line item is within the adjustment parameters: i) providing instructions to replace the line value with an



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adjusted line value (see claim 6c(i)); calculates an adjusted tax line value based on the adjusted tax line value, i.e. calculating an adjusted tax value based on the adjusted line value (see claim 6c(ii)); and provides instructions to replace said tax line value with said adjusted tax line value, i.e. providing instructions to replace the tax value with the adjusted tax value (see claim 6c(iii)).

40. As per claim 8, 378' teaches the system of claim 7 as described above. 378' further teaches application server further provides for notifying the vendor of the adjusted line value and the adjusted tax value, i.e. The electronic bill presentment and payment system of claim 6, wherein the application server further provides for notifying the vendor of the adjusted line value and the adjusted tax value (see claim 7).

41. As per claim 9, 378' teaches the system of claim 7 as described above. 378' further teaches invoice file further comprises a fee line value representing an amount payable by the customer as a fee on the product, i.e. invoice file further comprises a fee value representing an amount payable by the customer as a fee on the product (see claim 8); application server further provides for calculating, for each fee line value, an adjusted fee line value based on the adjusted line value, and providing instructions to replace the fee line value

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with the adjusted fee line value, i.e. application server further provides for: v) calculating an adjusted fee value based on the adjusted line value, and vi) providing instructions to replace the fee value with the adjusted fee value (see claim 8(v)).

42. As per claim 10, 378' teaches the system of claim 9 as described above. 378' further teaches application server further provides for notifying the vendor of the adjusted line value and the adjusted tax value, i.e. application server further provides for notifying the vendor of the adjusted line value and the adjusted tax value (see claim 9).

43. As per claim 11, 378' teaches the system of claim 10 as described above. 378' further teaches the invoice file further comprises a second product price line value representing an amount payable by the customer for said second product provided by the vendor, the tax line value represents an amount payable by the customer as a tax on both said first product and on said second product, and the fee value represents an amount payable by the customer as a fee on both said first product and on said second product, i.e. invoice file further comprises a second line value representing an amount payable by the customer for a second product provided by the vendor, the tax value represents an amount payable by the customer as a tax on both the product

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and the second product, and the fee value represents an amount payable by the customer as a fee on both the product and the second product (see claim 9).

### **Conclusion**

44. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Dent et al., U.S. Patent No. 6,128,603 teaches a consumer-based bill management and payment system is configured to receive, analyze, manage and pay electronic billing statements received from the biller over the Internet.

b. TurboTax for Windows User's Guide Tax Year 1997 teaches electronic tax filling.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chuks Onyezia Esq. whose telephone number is 571-270-1372. The examiner can normally be reached on first Friday off.

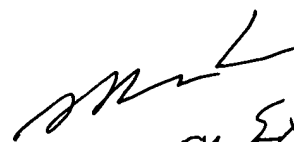
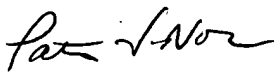
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on 571-272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Chuks Onyezia 10/12/2006

  
Primary Examiner  
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SUPERVISORY PATENT EXAMINER

10/12/06